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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,375	03/17/2004	Scott Lucas	CRM-3 CONT	5480
1473 7590 01/04/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			EXAMINER BIBBEE, JARED M	
			ART UNIT 2169	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/04/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/803,375

Applicant(s)

LUCAS ET AL.

Examiner

Jared M. Bibbee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/5/2004 and 10/2/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Examiner acknowledges and accepts the cancellation of claims 1-57 via preliminary amendment filed on 8/05/2004.

Priority

1. The examiner recognizes and accepts the applicants' claim for priority to 09/28/2001 based on continuation of application 09/966355.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 58-97 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 58, 64, 68, 74, 78, 84, 88, and 94, these claims simply represents an abstract idea where the limitations simply provide the user with an opportunity to display or transmit an object but nothing in the claim reflects if the object is actually presented to the user. Therefore the claim fails to provide a useful, concrete, and tangible purpose or result. Applicant is reminded that patent protection is limited to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Since the claims presented by the applicant are indeed simply abstract ideas, the claims are not covered by the statutory categories of patentable subject matter set forth in 35 U.S.C.

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101. An abstract idea is categorized as one of the three judicially created exceptions to patentable subject matter (the three exceptions are Laws of Nature, Natural Phenomena, and Abstract Ideas). The courts have concluded that in order to patent on of the three judicial exceptions to the statutory categories of the invention the claimed subject matter must have a practical, real-world application that produces a useful, concrete, and tangible result (*State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02*).

In order to overcome this rejection, the applicant must add a final limitation to independent claims 58, 64, 68, 74, 78, 84, 88, and 94 showing a step of actually displaying the list of individuals or a transmitted object to the user in the form of a view. By adding this conclusionary step, the applicant will add to the claimed invention a useful, concrete, and tangible result that arises from a practical application of the method steps previously mentioned in the claim.

Claims 59-63, 65-67, 69-73, 75-77, 79-83, 85-87, 89-93, and 95-97 are rejected because they contain the deficiencies of claims 58, 64, 68, 74, 78, 84, 88, and 94 respectively.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 58-97 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claims 58, 64, 68, 74, 78, 84, 88, and 94, the phrase "providing the user with an opportunity" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are actually carried out and are part of the claimed invention.

Claims 59-63, 65-67, 69-73, 75-77, 79-83, 85-87, 89-93, and 95-97 are rejected because they contain the deficiencies of claims 58, 64, 68, 74, 78, 84, 88, and 94 respectively.

Allowable Subject Matter

6. Claims 58-97 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cook (U.S. 2002/0059095 A1) is cited to teach a system and method for generating, capturing, and managing customer lead information over a computer network.

Siefert (U.S. 5,699,526) is cited to teach ordering and downloading resources from computerized repositories.

Brandt et al (U.S. 2003/0045958 A1) is cited to teach a personal feedback browser for obtaining media files.

Inquiries

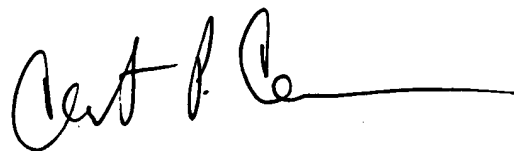
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared M. Bibbee whose telephone number is 571-270-1054. The examiner can normally be reached on IFP.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMB 



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